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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,145	07/22/2003	Stephen W. Boyd	004-001-C1	8267
32746	7590	05/08/2006	EXAMINER	
HOEKENDIJK & LYNCH, LLP			NGUYEN, VI X	
P.O. BOX 4787			ART UNIT	
BURLINGAME, CA 94011-4787			PAPER NUMBER	

3734
DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,145

Applicant(s)

BOYD, STEPHEN W.

Examiner

Victor X. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 28-36, 61 and 62 is/are pending in the application.
- 4a) Of the above claim(s) 1-15, 36, 61 and 62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16 and 28-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group II, claims 16 and 28-35, Specie 9, Figs. 25-28 in 9/30/2005 is acknowledged.

Claims 1-15,36 and 61-62 are withdrawn from further consideration pursuant to 37 CFR

1.142(b) as being drawn to a non-elected species, there being no allowable generic or linking claim. Election was made **without traverse** in the reply filed on 9/30/2005.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 16 and 28-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,3-4 and 11 of U.S. Patent No. 6,629,953. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite the same subject matters as following: a device for removing material from a vascular site comprising: an expandable cage which has a plurality of openings in the expanded position, where the openings being formed by rigidly connected elements, a material removing element positioned within the cage. As to claims 28-33 are not

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patentably distinct from each other because they are essentially the same as those in the cited patent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basic for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 16, 28-30 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Sokolik (3,320,957).

Sokolik discloses in figures 1-2 and 10, a device for removing material from a vascular site having the limitations as recited in claims 16 and 28, including: a cage (16) has a plurality of openings (the openings occur at 34,43) and has an inner surface, the openings are formed by rigidly connected elements (33,44 are considered as rigidly connected elements), where a sheath (30) is retractable relative to the cage to permit the cage to expand, and where a material removing element (51, see col.1, lines 18-25 and col. 3, lines 60-70) positioned within the cage that is capable of removing the material extending into the openings. As to claims 29-30, where elements 33,44 can be deformed within an elastic range (see col. 3, lines 20-25, these resilient shearing bars can be interpreted broadly that these bars can be characterized as deformed within the elastic range of material when moving from the expanded position to the collapsed position. As to claim 33, where the cage forms 2-10 openings (see col.2, lines 47-50, these openings occur at each of the four slots).

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Claims 28 and 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Fearnot (5,100,423).

Fearnot discloses in figures 4-5 and 8, a device for removing material from a vascular site having the limitations as recited in claim 28, including: a sheath (140), a cage (150) has a plurality of openings in the expanded positions, where the expandable cage is contained within the sheath, where the sheath is retractable to the cage to expose the cage, and where a material removing element (104, see col. 3, lines 30-40) positioned within the cage to remove material extending into the opening. As to claims 31-32, where a collapsible bag (202) positioned to receive the material removed (200) by the material removing element, where the bag also coupled to the material removing element,

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34-35 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Sokolik (3,320,957)

Sokolik discloses the invention substantially as claimed. Sokolik is silent regarding the openings of the cage have a length of at least 1 mm and the openings of the cage have a size of at least 0.5 mm.

Regarding claims 34-35, the device could make the openings of the cage have a length of at least 1 mm and the openings of the cage have a size of at least 0.5 mm as best seen in fig. 1. In

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the alternative, it has been held that changes in size only require routine skill in the art.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the device with the openings of the cage have a length of at least 1 mm and the openings of the cage have a size of at least 0.5 mm and a minor modification of Sokolik's device would adopt the same for use under various conditions of service, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re. Aller, 220F, 2d 454, 105 USPQ 233.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,277,138 to Levinson U.S. Pat. No. 6,187,025 to Machek


U.S. Pat. No. 6,179,859 to Bates U.S. Pat. No. 6,383,195 to Richard


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Victor X Nguyen
Examiner
Art Unit 3731

Vn 
12/27/2005


ANH TUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER